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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,734	08/03/2001	Norman Yamamoto	310048-650	8752

7590

01/15/2004

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

21

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,734

Applicant(s)

YAMAMOTO ET AL. *cd*

Examiner

Mark T Henderson

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,11,12,14-17,19,21,22 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,11,12,14-17,19,21,22 and 24-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 5, 6, 11, 15, 17, 21, 22, 24, 28 have been amended for further examination. Claims 4 and 20 have been canceled. Claim 29 has been added.

Oath/Declaration

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2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not include the notary's signature, or the notary's signature is in the wrong place.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 14 recites the limitation "said rear pocket" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 11, 16, 21, 22, 25, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (6,206,602) in view of Walters (5,118,137).

Yamamoto et al discloses in Fig. 2, a binder assembly and system comprising: front and rear plastic covers (12), wherein the front cover is transparent with an opaque frame coating (22, Col. 2, lines 58-60) defining an open area (as seen in Fig. 1); wherein the covers are secured together at a binding (16, 18 and 20); and an inner transparent pocket (26) secured to the inner surface (12A) of the front cover (Col. 2, lines 60-65) at a pocket-to-cover bond zone, wherein the bond zone is free of expansion structure; and having inner, outer, top and bottom edges, permitting quick insertion of visual material information (30, as stated in Col. 2, lines 65-67) from a top (28) of the inner areas of the pocket.

However, Yamamoto et al does not disclose a binder assembly: wherein the inner pocket has the same dimensions as the cover and is secured along its outer edge and its bottom edge, but

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is free and unsecured to the cover at the top and inner edges; and wherein the inner pocket is formed of a sheet secured to a binding and cut along the binding.

Walters discloses in Fig. 5 and 6, a binder (Col. 2, line 12) having an inner pocket (20) dimensioned at any desirable size (Col. 2, lines 32-34) and is secured (sealed, as is stated in Col. 2, lines 17, 18 and 36 and 37) along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly and replace the pocket with a pocket only secured at its outer and bottom edge as taught by Walters for the purpose of allowing easier insertion of material in the pocket.

In regards to **Claim 16**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the rear cover the same as the front cover for the purpose of disclosing additional visual displays, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 25 and 26**, the inner pocket is formed of a sheet secured to a binding and cut along the binding does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior

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art was made by a different process (see MPEP 2113). Therefore, it would be obvious to incorporate a secured sheet that is cut to form a pocket opened along particular edges.

5. Claims 5, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al in view of Walters and further in view of Wilson, Wyant and Koba (6,222,947).

Yamamoto et al discloses in Fig. 2, a binder assembly and system comprising: front and rear plastic covers (12), wherein the front cover is transparent with an opaque frame coating (22, Col. 2, lines 58-60) defining an open area (as seen in Fig. 1); wherein the covers are secured together at a binding (16, 18 and 20); and an inner pocket (26) secured to the inner surface (12A) of the front cover (Col. 2, lines 60-65) and having inner, outer, top and bottom edges, permitting quick insertion of visual material information (30, as stated in Col. 2, lines 65-67) from a top (28) of the inner areas of the pocket.

However, Yamamoto et al does not disclose a binder assembly: wherein the inner pocket has the same dimensions as the cover and is secured along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges; a transparent dividers with tabs which are mounted in the binder; and wherein the rear cover having a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material; and a system further including a computer, a keyboard and a printer.

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Walters discloses in Fig. 5 and 6, a binder (Col. 2, line 12) having an inner pocket (20) dimensioned at any desirable size (Col. 2, lines 32-34) and is secured (sealed, as is stated in Col. 2, lines 17, 18 and 36 and 37) along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly and replace the pocket with a pocket only secured at its outer and bottom edge as taught by Walters for the purpose of allowing easier insertion of material in the pocket.

However, Yamamoto et al as modified by Walters does not disclose having a transparent dividers with tabs which are mounted in the binder; and wherein the rear cover having a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material; and a system further including a computer, a keyboard and a printer.

Wilson discloses in Fig. 7, 8 and 9, a binder assembly having mounted dividers (70) with outwardly projecting tabs (72) as is stated in Col. 4, lines 35 and 36.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include mounted dividers as taught by Wilson for the purpose of organizing sheet information placed in the ring binder.

However, Yamamoto et al as modified by Walters and Wilson does not disclose wherein the rear cover having a partial pocket extending half the area of a rear cover and formed of the

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same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material.

Wyant discloses in Fig. 1, 3, and Col. 1, lines 5-10, an assembly which could be a binder assembly comprising a rear pocket (47) having a folded up first area (36) and a folded down second area (lower portion of 42) to secure the pocket in its folded position, wherein the pocket is secured along its outer edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include a pocket formed with a folded up first portion and a folded down second portion as taught by Wyant for the purpose of providing a more securely reinforced pocket.

However, Yamamoto et al as modified by Walters, Wilson and Wyant does not disclose wherein the system further including a computer, a keyboard and a printer for displaying, forming and printing of the visual insert.

Koba discloses in Col. 1, lines (9-13) and Col. 3, lines (20-36) a computer, (2), a keyboard (7) and a printer (9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly with a computer, keyboard and printer for displaying, forming and printing of a visual display substrate insert.

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6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al as modified by Walter, Wilson, Wyant, Koba, and further in view of Brown et al.

Yamamoto et al as modified by Walter, Wilson, Wyant and Koba discloses a binder assembly comprising all the elements as claimed in Claim 5, and as set forth above. However, Yamamoto et al does not disclose a binder assembly: having slits in the pockets.

Brown et al discloses in Fig. 5, a binder having an inner pocket (45) that is secured along its outer edge and its bottom edge, comprises slits (53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly with a pocket having slits as taught by Brown et al for the purpose of mounting and holding additional information.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the slits on any desired pocket, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Therefore, it would have been an obvious to place the slits at any desired pocket location, since applicant has not disclosed why it would be critical to place the slits at a particular pocket location.

7. Claim 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al in view of Walter and further in view of Wyant.

Yamamoto et al as modified by Walter discloses a binder assembly comprising all the elements as claimed in Claim 11, and as set forth above. However, Yamamoto et al does not

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disclose a binder assembly wherein the rear cover has a pocket formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear pocket is transparent.

Wyant discloses in Fig. 1, 3, and Col. 1, lines 5-10, an assembly which could be a binder assembly comprising a rear pocket (47) having a folded up first area (36) and a folded down second area (lower portion of 42) to secure the pocket in its folded position, wherein the pocket is secured along its outer edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include a pocket formed with a folded up first portion and a folded down second portion as taught by Wyant for the purpose of providing a more securely reinforced pocket.

8. Claims 17 and 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al in view of Walter and further in view of Wilson and Wyant.

Yamamoto et al discloses in Fig. 2, a binder assembly and system comprising: front and rear plastic covers (12), wherein the front cover is transparent with an opaque frame coating (22, Col. 2, lines 58-60) defining an open area (as seen in Fig. 1); wherein the covers are secured together at a binding (16, 18 and 20); and an inner transparent pocket (26) secured to the inner surface (12A) of the front cover (Col. 2, lines 60-65) at a pocket-to-cover bond zone, wherein the bond zone is free of expansion structure; and having inner, outer, top and bottom edges,

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permitting quick insertion of visual material information (30, as stated in Col. 2, lines 65-67) from a top (28) of the inner areas of the pocket.

However, Yamamoto et al does not disclose a binder assembly: wherein the inner pocket has the same dimensions as the cover and is secured along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges; a plurality of transparent dividers; wherein a rear cover having a pocket formed of the same sheet as the rear cover; and wherein the inner is formed by cutting along the binding to form the inner free edge of the pocket.

Walters discloses in Fig. 5 and 6, a binder (Col. 2, line 12) having an inner pocket (20) dimensioned (length or width) at any desirable size (Col. 2, lines 32-34) and is secured (sealed, as is stated in Col. 2, lines 17, 18 and 36 and 37) along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly and replace the pocket with a pocket only secured at its outer and bottom edge as taught by Walters for the purpose of allowing easier insertion of material in the pocket.

However, Yamamoto et al as modified by Walters does not disclose having a transparent dividers with tabs which are mounted in the binder; and a rear cover having a pocket formed of the same sheet as the rear cover

Wilson discloses in Fig. 7, 8 and 9, a binder assembly having mounted dividers (70) with outwardly projecting tabs (72) as is stated in Col. 4, lines 35 and 36.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include mounted dividers as taught by Wilson for the purpose of organizing sheet information placed in the ring binder.

However, Yamamoto et al as modified by Walter and Wilson does not disclose a rear cover having a pocket formed of the same sheet as the rear cover.

Wyant discloses in Fig. 1, 3, and Col. 1, lines 5-10, an assembly which could be a binder assembly comprising a rear pocket (47) having a folded up first area (36) constructed of the same sheet as the rear cover (32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly with a pocket formed of the same sheet as the rear cover as taught by Wyant for the purpose of providing a means in which to manufacture the binder assembly efficiently by reducing the number of added materials.

In regards to **Claim 27**, the inner pocket is formed of a sheet secured to a binding and cut along the binding does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to incorporate a secured sheet that is cut to form a pocket opened along particular edges.

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9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al in view of Walters and further in view of Koba.

Yamamoto et al discloses in Fig. 2, a binder assembly and system comprising: front and rear plastic covers (12), wherein the front cover is transparent with an opaque frame coating (22, Col. 2, lines 58-60) defining an open area (as seen in Fig. 1); wherein the covers are secured together at a binding (16, 18 and 20); and an inner pocket (26) secured to the inner surface (12A) of the front cover (Col. 2, lines 60-65) and having inner, outer, top and bottom edges, permitting quick insertion of visual material information (30, as stated in Col. 2, lines 65-67) from a top (28) of the inner areas of the pocket.

However, Yamamoto et al does not disclose a binder assembly: wherein the inner pocket has the same dimensions as the cover and is secured along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges; and a system further including a computer, a keyboard and a printer.

Walters discloses in Fig. 5 and 6, a binder (Col. 2, line 12) having an inner pocket (20) dimensioned at any desirable size (Col. 2, lines 32-34) and is secured (sealed, as is stated in Col. 2, lines 17, 18 and 36 and 37) along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly and replace the pocket with

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a pocket only secured at its outer and bottom edge as taught by Walters for the purpose of allowing easier insertion of material in the pocket.

However, Yamamoto et al as modified by Walters does not disclose a system further including a computer, a keyboard and a printer for displaying, forming and printing of the visual insert.

Koba discloses in Col. 1, lines (9-13) and Col. 3, lines (20-36) a computer, (2), a keyboard (7) and a printer (9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly with a computer, keyboard and printer for displaying, forming and printing of a visual display substrate insert.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Takemura, Buxton, and Moor disclose and assembly having similar inner pockets.

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Response to Arguments

10. Applicant's arguments filed on November 2, 2003 have been fully considered but they are not persuasive.

In response to applicant's arguments that there is no suggestion to combine the references of Walters and Yamamoto et al, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Walters reference is only cited for disclosing an inner pocket of a binder assembly which can be secured on an outer and bottom edge and free form being secured on an inner and top edge. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly and replace the pocket with a pocket only secured at its outer and bottom edge as taught by Walters for the purpose of allowing easier insertion of material in the pocket. Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

January 9, 2004



Daniel W. Howell
Primary Examiner
Art Unit 3722